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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
913,500	06/07/78	Masaru Iwanami	UWP1764

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New York, N. Y. 10017

EXAMINER	
NRizzo	
ART UNIT	PAPER NUMBER
122	9

DATE MAILED: MAILED

DEC 3 1979

GROUP 120

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☒ Responsive to communication filed on 09-12-79 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of Referances Cited, Form PTO-892.
2. ☐ Notice of Informal Patent Drawing, PTO-948.
3. ☐ Notice of Informal Patent Application, Form PTO-152.
4. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12 are pending in the application.
   Of the above, claims 8, 9, 10 are withdrawn from considaration.
2. ☐ Claims _____ have bean cancellad.
3. ☒ Claims 2-7 are allowed.
4. ☒ Claims 1, 11-12 are rajactad.
5. ☐ Claims _____ are objacted to.
6. ☒ Claims 1-12 are subject to restriction or election requirement.
7. ☐ The formal drawings filed on _____ are accaptable.
8. ☐ The drawing corraction raquest filad on _____ has been ☐ approved. ☐ disapproved.
9. ☐ Acknowledgment is made of tha claim for priority under 35 U.S.C. 119. The certifiad copy has
   ☐ bean racaivad. ☐ not bean racaivad. ☐ baen filad in parent application, sarial no. _____,
   filad on _____.
10. ☐ Since this application appears to ba in condition for allowance excapt for formal matters, prosacution as to tha marits is closed in accordance with the practice under Ex parta Quayla, 1935 C.D. 11; 453 O.G. 213.
11. ☐ Other

PTOL-326 (rev. 7-79)

EXAMINER'S ACTION

1. The claims are 1-12.

2. The requirement for restriction is repeated. As was stated in the last Office action, two separate and distinct concepts are present which are identified as Group A and Group B in paper No. 5. Applicants traverse the rejection urging that there is, in fact, one invention present. Applicants argue that (a) all of the claims have been examined and (b) all of the claims fall within the same class.

3. Applicants' ~~through~~ thorough reponse has been carefully evaluated and deemed to be unpersuasive. As to point (a) there is nothing in the rules that indicate that a different posture may not be adopted by the PTO in a subsequent action. As to point (b) whether all fall within the same class is not necessarily binding. We turn to the claims for a further analysis.

4. Applicants' claims are drawn to final products of the type found in claim 1. Process claims 8, 9 and 10 represent three separate and distinct methods of preparing the compounds of claim 1. Applicants are also claiming intermediate compounds as found in claim 11. Thus, it is quite clear that no necessary connection exists

between the compounds and the process. It is also quite clear from the process claims presented that more than one method exists for preparing the final products. See MPEP 806.05 (b), cited earlier and, as stated, believed to be directly in point. Thus, to summarize the two inventions present are, as follows:

Group A. Compounds (claims 1-7, 11-12).

Group B. Process (claims 8-10). Applicants have elected Group A with traverse.

5. Compound claims 2-7 are allowed.

6. Claims 1, 11 are rejected as failing to comply with the requirements of 35 USC 112, 1st and 2nd per. Terms such as "ester residue", all occurrences, "an aryl group", "an aroyl group", "aralkyl ester residue", "a heterocyclic residue", are all both two broad and indefinite. What, for example, is to be conveyed by the term "residue"?; by the term "aryl"?; by the term "a heterocyclic residue"?. In so far as the examiner is aware these terms do not possess fixed meanings. Attention is called to the Wiggins decision (In re Wiggins 179 USPQ 421). In this case the CCPA held two out of three claims as not patentable because of faulty language. The claim that was allowed had not been rejected on 35 USC 112. This decision clearly demonstrates the dramatic importance of language in claims particularly in pharmaceutical compounds. See also In re Hawkins 179 USPQ 157.

7. Claims 11-12 are rejected as being obvious over the combination of newly cited Takano et al and Ochiai et al. Note in Takano the very extensive number of compounds disclosed. All of the compounds seem to possess the same general utility.

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EXAMINER
GROUP ART UNIT 122

NRizzo/maw
A/C 703
557-3032
11/19/79